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**FEB 29 2008**

**OFFICE OF PETITIONS**

In re Application of	:	
Missinhoun et al.	:	
Application No. 09/608293	:	DECISION ON APPLICATION
Filing or 371(c) Date: 06/30/2000	:	FOR PATENT TERM ADJUSTMENT
Attorney Docket Number:	:	
10022/225	:	

This is a decision on the "Request for Reconsideration of Patent Term Adjustment Pursuant to 37 C.F.R. 1.705(b)," filed September 24, 2007.

The application for patent term adjustment is **DISMISSED**.

On June 26, 2007, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 257 days.

On September 24, 2007, applicant timely submitted the instant application for patent term adjustment<sup>1</sup>. Applicant requests review of the Patent Term Adjustment determination, in particular, the 127 day period of reduction for applicant delay for the time period extending from the day after the August 29, 2006, Response after non-final Action was filed, or August 30, 2006, to the January 3, 2007, filing of the Response after non-final Action (Response to Notice of Non-Compliant Amendment).

Applicant does not dispute the delay of 727 days attributed to the Office under 1.702(a), for failing to mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a). Nor does Applicant dispute the delay of 64 days attributed to Applicant under 37 CFR 1.704(b), for filing a reply to the non-final Office action, mailed August 27, 2003, more than three (3) months after the mail date of the Office action; the delay of 92 days attributed to Applicant under 37 CFR 1.704(b), for filing a reply to the final Office action,

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<sup>1</sup> PALM records show that the Issue Fee payment was received in the Office on September 24, 2007.

mailed April 21, 2004, more than three (3) months after the mail date of the final Office action, or the delay of three (3) days for filing a reply to the non-final Office action, mailed January 11, 2005, more than three (3) months after the mail date of the Office action. Applicant also does not dispute the delay of 90 days attributed to Applicant under 37 CFR 1.704(b), for filing a reply to the final Office action, mailed June 15, 2005, more than three (3) months after the mail date of the final Office action, or the delay of 94 days attributed to Applicant under 37 CFR 1.704(b), for filing a reply to the non-final Office action, mailed February 27, 2006, more than three (3) months after the mail date of the non-final Office action.

Regarding the delay of 127 days attributed to Applicant under 37 CFR 1.704(c)(7), for filing the Response to Notice of Non-Compliant Amendment on January 3, 2007, after filing the response to the non-final Office action on August 29, 2006,

37 CFR 1.704(c) provides, in pertinent part, that:

Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

(7) Submission of a reply having an omission (§1.135(c)), in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed;

The MPEP 2732 further explains that

37 CFR 1.704(c)(7) establishes submission of a reply having an omission (37 CFR 1.135(c)) as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. Submitting a reply having an omission requires the Office to issue an action under 37 CFR 1.135(c) and await and process the applicant's reply to the action under 37 CFR 1.135(c) before the initial reply (as corrected) can be treated on its merits. In addition, 37 CFR 1.704(c)(7) provides that in such a case the period of adjustment set forth in 37 CFR 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed. The reference to 37 CFR 1.135(c) is parenthetical because 37 CFR 1.704(c)(7) is not limited to Office actions under 37 CFR 1.135(c) but applies when the Office issues any action or notice indicating that a reply has an omission which must be corrected: e.g., (1) a decision on a petition under 37 CFR 1.47 dismissing the petition as lacking an item necessary to grant the petition; or (2) a notice indicating that the computer readable format sequence listing filed in reply to a Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures (PTO-1661) does not comply with 37 CFR 1.821 et seq.

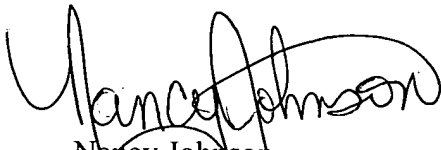
In this instance, Applicant filed a response (Amendment) to the non-final rejection, on August 29, 2006. However, the Amendment was non-compliant. Applicant was notified in a Notice of Non-Compliant Amendment. Applicant filed a supplemental reply in the form of an Amendment in response to the Notice of Non-Compliant Amendment, on January 3, 2007. Pursuant to 37 CFR § 1.704(c)(7) the patent term adjustment should have been reduced by one hundred twenty-seven (127) days for applicant delay, from August 30, 2006, to January 3, 2007, in filing a Response correcting the omission.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **two hundred fifty-seven (257) days** (727 days of PTO delay, reduced by 470 (64+92+3+90+94+127) days of applicant delay).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Publications Division for issuance of a patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to Attorney Derek Woods at (571) 272-3232.



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